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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,500	03/24/1999	ANDREW BICKFORD HAYNS	HAYNS-1	2980

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EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

27

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/202,500

Applicant(s)
Hayns

Examiner
Ivars Cintins

Art Unit
1724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 27, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-23 and 30-33 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-23 and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Prosecution before the Primary Examiner is hereby reopened, and the Final Rejection dated July 31, 2002 is withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The term "selected from the group comprising" (claim 20, lines 2-3) is improper Markush language, and hence indefinite. Applicant is advised that an amendment changing "comprising" to "consisting of" in the above noted expression would overcome this rejection. See M.P.E.P. § 2173.05(h) (I).

In view of Applicant's remarks presented on pages 12-14 of the brief filed February 27, 2003, it is agreed that even if it were obvious to one of ordinary skill in the art at the time the invention was made to substitute the sizing agent of Novak for the sizing agent of Wiegand et al., the resultant product would not correspond to the claimed material. As correctly pointed out by Applicant, the final waterproofing agent of Novak is a precipitated fatty acid soap, and not the fatty acid itself; and

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therefore, the product resulting from the previously proposed substitution would not have a composition comprising one or more aliphatic carboxylic acids adsorbed onto a base formed substantially of cellulose fibers, as required by the claims of this application. Accordingly, the rejection based upon Wiegand et al. in view of Novak, contained in the Final Rejection, is hereby withdrawn.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18-23 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiegand et al. in view of German Patent No. DE 2358808. As pointed out in a previous Office Action, Wiegand et al. discloses an oil sorbing material which comprises a non-woven sheet-like matrix, which matrix contains cellulose fibers, such as cotton (col. 2, line 4). This reference also discloses that the cellulose fibers can be treated with a sizing agent (col. 2, lines 7-8); further discloses that the matrix has a density within the recited range (col. 3, line

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59); and still further discloses that this matrix can contain a foam material (col. 2, line 62). Accordingly, this primary reference discloses the claimed invention with the exception of the particular sizing material employed, the type of foam (i.e. open-cell) material employed (claim 22), and the thickness of the matrix (claim 32). German Patent No. DE 2358808 discloses modifying a similar cellulosic oil sorbent material with a high molecular weight (i.e. having a minimum of 14 carbon atoms) fatty acid, in order to enhance the hydrophobicity of the cellulosic material. This German patent further teaches (see page 2, line 22; and page 5, lines 1-12) that such a high molecular weight fatty acid is superior to conventional waterproofing (sizing) agents such as paraffin. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the higher molecular weight fatty acid treatment of the secondary reference for the paraffin treatment of the primary reference, in order to obtain the advantages disclosed by this secondary reference for the product of the primary reference. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an open-cell foam as the foam material called for in the primary reference (see col. 2, line 62), in order to increase the porosity, and thereby the adsorption capability, of the modified

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primary reference material. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a matrix having the thickness recited in claim 32 in the material of the modified primary reference material, in order to facilitate handling of this modified primary reference material.

Applicant's arguments presented in the brief filed February 27, 2003 have been noted and carefully considered. Most of these arguments no longer appear to be relevant in view of the new grounds of rejection. However, with respect to the argument that the material of Wiegand et al. is not a "filter," it is pointed out that web or mat-like structure of the primary reference (see col. 1, lines 41-42) is clearly sufficiently porous to permit a fluid to pass therethrough; and therefore, this structure is inherently capable of being used as a filter. Notwithstanding the dictionary definition presented by Applicant on page 15 of the brief filed February 27, 2003, it is well settled that a claim to a product is not limited to the manner in which the product is intended to be employed. Accordingly, the term "filter material" in claims 18-23 and 30-33 merely requires a material which is capable of functioning as a filter, and does not require any actual filtration step. See *In re Casey*, 152

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USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963); and *Ex parte Masham*, 2 USPQ2d 1647 (1987). The porous material of the modified primary reference is clearly capable of passing a fluid containing impurities therethrough, and this capability is all that is required by the recitation of "filter" in the claims of this application.

Applicant should note that a copy of German Patent No. DE 2358808 is not being furnished with this Office action, because this reference was cited by Applicant in the IDS submitted March 29, 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas Dunn, can be reached at (703) 308-3318.


The fax phone numbers for this art unit are: (703) 872-9311 for "Official" faxes after Final Rejection; (703) 872-9310 for all other "Official" faxes; and (703) 872-9492 for "Draft" and other "Unofficial" faxes.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
May 15, 2003